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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,528	01/07/2002	Eric Wood	ITI-138D (20109.65)	1745
7590	01/02/2004		EXAMINER	
Michael I. Wolfson Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799			VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,528	WOOD, ERIC
Examiner	Art Unit	
Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 January 2002.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. 07/934,678.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br><br>U.S. Patent and Trademark Office | 6) <input type="checkbox"/> Other: _____ .                                   |

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1. Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17, line 1, "the seal arrangement" technically lacks antecedent basis.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 9-12 and 14-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Chick in view of Nissen. Chick discloses the basic claimed process of lining a lateral pipe using a lining tube of resin impregnated material which is everted into the lateral from an elbow pipe within the main pipe, the elbow pipe and the lower portion of the lining tube forming an inflatable seal means against the wall of the main pipe. As such, this seal meets the requirements of instant claims 10 and 12, which call

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for an inflatable means which is inflated by the fluid medium used to line the lateral and which comprises a bag or bladder which is inflated against the main pipe surface. What is lacking are the aspects of the collar on the lateral lining tube and the seal means being inflated by a fluid medium at a lower pressure than that used to insert the lateral lining (as set forth in claim 10). Concerning the latter, once the lateral lining has been inflated to some extent and is being everted into the lateral, it would appear inherent, or in the alternative, obvious, that most of the fluid pressure to do the inversion would be concentrated at the everting end and not the sealed end. See also column 3, lines 14-19, disclosing devices by which a mechanical lodging of the elbow pipe (and hence the seal means) against the main pipe wall would relieve the eversion pressure felt at that area. Nissen discloses a lining tube with the instant collar and teaches that such a collar would be used to anchor the tube to the entrance of the pipe being lined. See column 2, lines 36-39 of Nissen. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the liner of Chick as taught by Nissen to facilitate the holding in place of the liner as it is everted.

3. Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Chick in view of Nissen and further in view of Wood et al -974. Chick and Nissen have been discussed in

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paragraph 2, supra, and teach the basic claimed process lacking essentially the aspect of using spaced, diametrically opposed pillows as the inflatable bag or bladder. Wood et al teaches same in a pipelining operation and their use in the process of Chick would have been obvious to further augment the seal.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 9-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,624,629. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and those of the previously issued patent virtually mirror one another, the only difference being that the end of the lateral lining is bonded to the collar, a distinction which really does not effect the method in that one of ordinary skill in the art would have bonded the liner or made same integral in some manner.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Japanese Patent 4-355,116 discloses inflatable seals which help secure an elbow pipe to the surface of the main pipe during lateral lining eversion. Smith teaches inflatable pillows (or rolling pigs). Friedrich teaches a bushing installed in the opening of a lateral. Kamiyama et al -401 discloses (Fig. 11) inflatable seals (242) which hold a collar (204a) of the lateral against the surface of the main pipe.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is (571) 272-1211.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

M. Vargot

December 27, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

*12/27/03*